

REMARKS

Claims 1, 3, 5, 9, 12-13, 24, 27-29, and 32-33 have been rejected as anticipated by Rozenkranc. Applicants do not concede that this rejection is proper, for at least the reasons discussed in Applicants' previous response. However, in order to expedite prosecution, Applicants have amended claims 1 and 3 to include the subject matter of claims 10-11, which are not subject to this rejection. Applicants respectfully request that this rejection be withdrawn in view of the amendments herein.

Claims 1 and 3 have also been amended to recite that the unit includes an assembly that comprises a blade carrier defining the rear wall, and that the rear wall is formed from sheet metal. Support for this language is found, e.g., at page 4, lines 14-18 of Applicants' specification. These features are neither taught nor suggested by the art of record.

The subject matter of claims 10-11 stands rejected as unpatentable over either Rozenkranc or Brown (U.S. 2004/0055156) combined with what the Examiner refers to as "Applicants' Admitted Prior Art (AAPA)." "AAPA" consists of a statement made by the Examiner in the office action mailed August 12, 2005, to the effect that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a separate piece made of metal on the device of Rozenkranc in order to provide an attachable component. The court has long held that constructing a formerly integral structure in various elements involves only routine skill in the art and selecting a known material on the basis of its suitability for the invented use is a matter of obvious design choice." Applicants did not traverse this statement by the Examiner in Applicants' response to the August 12, 2005 office action because the Examiner's statement it pertained to dependent claims which Applicants believed to be patentable simply because they depended on an allowable base claim. Accordingly, arguing the point was not necessary to advance prosecution of the case in its posture at the time. As discussed in Applicants' last response, Applicants' silence in this regard did not constitute an admission that the Examiner's assertion was correct.

Applicants have incorporated the subject matter of claims 10-11 into claims 1 and 3 in the present response, and thus it is now appropriate to traverse the Examiner's statements concerning these claims.

First, with respect to Official Notice being taken that the features are "obvious," Applicants traverse this Official Notice as improper because obviousness is a legal conclusion that cannot be made by Official Notice. As indicated by MPEP 2144.03, "[i]n limited circumstances, it is appropriate for an examiner to take Official Notice of facts not in the record." MPEP 2144.03 (emphasis added). Whether claimed subject matter is obvious is a legal, not a factual determination.

Second, there is simply nothing in the record that would have suggested to the artisan to modify the razors of Rozenkranc or Brown to include a separate metal wall mounted on the plastic housing "in order to provide an attachable component." The art of record provides no indication that the razors of Rozenkranc or Brown would benefit from such a modification, nor that this modification could be made without deleteriously affecting the cost or robustness of the product. Instead, the only suggestion for the proposed modification is found in *Applicants' own disclosure*.

The Federal Circuit has held that *prima facie* obviousness cannot be established on such a basis. For example, in In re Deminski the court reversed a BPAI decision of obviousness, explaining that

[t]here is nothing in the prior art references, either singly or in combination, "to suggest the desirability, and thus the obviousness," of designing the valve assembly so that it can be removed as a unit.... There was no suggestion in the prior art to provide Deminski with the motivation to design the valve assembly so that it would be removable as a unit. *The board argues that if [the primary reference] had followed the "common practice" of attaching the valve stem to the valve structure, then the valve assembly would be removable as a unit. The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a*

whole would have been obvious at the time the invention was made. (In re Deminski, 796 F.2d 436, 442-443 (Fed. Cir. 1986), citations omitted, emphasis ours.)

In view of the above, Applicants respectfully request that the rejections of claims 10-11 as unpatentable be withdrawn and that all claims be allowed.

It is believed that no fees are due with this response. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00216-661001.

Respectfully submitted,

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